REMARKS

Initially, Applicants would like to thank the examiner for granting and conducting an in person interview June 16. The amendments made by this response are consistent with the remarks made during the interview.

The Office Action, mailed April 12, 2005, considered and rejected claims 1-38.[1]

To alleviate any confusion regarding the prosecution history and the rejections that now remain, Applicant will provide a brief history regarding the prosecution in this case, including the identification of all art and some of the responses that have been presented regarding that art.

HISTORY OF PROSECUTION

FIRST OFFICE ACTION- Oct 18, 2002

The first office action rejected all of the claims under 35 U.S.C. § 102 as being anticipated by both Intel Intercast Technologies[2] and Schein (U.S. Pat. No. 6,388,714).

AMENDMENT A - Feb 12, 2003

Amendment A, following an in person interview (with Mr. Rick Nydegger and Mr. Jens Jenkins on 2/5/03), traversed the grounds of rejection.

As indicated in Amendment A, and as discussed during the interview, it was stated:

> *Schein* and *Intel* neither anticipate nor make obvious the claimed invention. In particular, *Intel* fails to disclose or suggest a method for pausing the display of a television program in response to the selection of a hyperlink, as recited in the claims. In contrast, *Intel* discloses a method for using "a PC to watch TV and surf the Internet *at the same time*." (p.1, line 1, emphasis added). The *Intel* technology is in fact referenced the present application (described as "intercasting, in which world wide web-like pages are distributed to television sets via the vertical blanking interval."). (Paragraph 13).
>
> "The intercast information is currently either displayed in a split screen, or the display is toggled between the television program and the intercast information. In any event, to make use of the intercast signal the viewer must either miss part of the television program, or try to pay attention to the program while simultaneously concentrating on retrieving and understanding the intercast information. This is one of the major drawbacks of the intercast technology." (Paragraph 14).
>
> Accordingly, *Intel* does little more than identify a method for simultaneously viewing a television program while at the same time browsing interactive content. At no point does *Intel* make any reference to pausing a television program, as recited in the claims.

---

[1] Claims 1-38 were rejected as being unpatentable under 35 U.S.C. 103(a) as being unpatentable over Intel Intercase Technologies in view of U.S. Patent No. 5,426,534 (Nakata, et al.) for apparently the same reasons set forth in Section 8 of the office action, dated 7/24/03. Claims 1-38 were also rejected under 35 U.S.C. 103(a) as being unpatentable in view of U.S. Patent No. 5,426,534 (Schein, et al) for apparently the same reasons set forth in Section 9 of the office action, dated 7/24/03.

[2] The citation for this rejection was not originally provided, but following subsequent communications was identified as being located at http://www.intel.com/iaweb/intercast/index.htm. This cite is no longer operative to fetch the document that was previously located at that address, which is a single page document comprising a brief summary of an Intel Intercast ® technology, summarized within this paper. We will provide our copy upon request.

> *Schein* similarly fails to disclose or suggest a method for pausing the television program when selecting a hyperlink. Instead, like *Intel*, *Schein* discloses a method of "intercasting" that can be used to watch a television at the same time interactive data is viewed, using a remote 410 as a tool for navigating the web[3]. Furthermore, again like *Intel*, *Schein* also discloses a picture-in-picture type window 726 (Figure 12A) to allow the television program to be displayed without being blocked out by the interactive content, thus providing a clear contrary teaching to the system and method for pausing the television program when selecting a hyperlink, as claimed by applicant. Accordingly, neither reference overcomes the problem which is overcome by applicant's claimed method and system, in which the viewer is no longer required to "either miss part of the television program, or try to pay attention to the program while simultaneously concentrating on retrieving and understanding the intercast information." (Specification, paragraph 14).

FINAL OFFICE ACTION- Jul 24, 2002

The final office action rejected all of the claims under 35 U.S.C. § 102 as being anticipated by Schein again, for the same reasons, and under 35 U.S.C. § 103 for obviousness in view of a combination of Intel Intercast Technologies and Nakata (U.S. Pat. No. 5,426,534).

AMENDMENT B AFTER FINAL WITH RCE – Oct 20, 2003

Amendment B, following an in person interview (with Mr. Jens Jenkins on 10/6/03), traversed the grounds of rejection.

As indicated in Amendment A, and as discussed during the interview, it was stated:

> Schein, Intel and Nakata neither anticipate nor make obvious the claimed invention, either singly or in combination. In particular, Intel fails to disclose or suggest any method in which television programming is paused at all. To the contrary, Intel identifies a system in which a user can "use a PC to watch TV and surf the Internet at the same time." (Intel p. 1, ln. 2)

With particular regard to some new assertions made with regard to Schein in the Final Action, it was stated:

> Schein fails to disclose any method or system for pausing a television program while a television program it is being broadcast and in response to the selection of a hyperlink, as is recited in the claims. Schein does disclose a remote control 410 in Figure 7 and the Examiner has stated "that one of ordinary skill in the art would have had no difficulty in realizing that the pause function is inherently included in a remote control." Nevertheless, even assuming, *arguendo*, that the remote control could be operated to pause a VCR, it would be improper to suggest that the remote control could inherently pause live television programming in a time-shifted manner, as recited in the claims.

With particular regard to the new assertions made with regard to Nakata, it was stated:

---

[3] The Office Action draws reference to a remote control 410, which is purported 'to pause the display of a television program 732.' However, to the contrary, *Schein* at no point mentions or infers that the remote control can be used to pause the television program being displayed at the television system. Rather, remote 410 is merely described in *Schein* as a tool for navigating information Services "such as News, Weather, Sports, Scores, Financial Data,Local Traffic, etc." (col. 11, ll. 1-10). In fact, the image of the remote 410 shown in Figure 7 does not even include a pause button and the term "pause" is not mentioned at any time in *Schein*.

Finally, Nakata is directed to a "multiple-deck magnetic information recording and reproducing apparatus for dubbing recorded information from one magnetic recording medium to another magnetic recording medium." (Col. 1, ll. 10-14). Even though the Nakata device includes standard video recording capabilities, such as recording and pausing, Nakata in no way suggests or discloses any method for temporarily pausing a television broadcast in a time-shifted way, and particularly in response to the selection of a hyperlink that is displayed with the programming. In fact, Nakata fails to disclose the recording of broadcast television at all. Instead, Nakata discloses very specific recording procedures for beginning and ending a recording from one magnetic tape to another magnetic tape and so as to minimize the number of control buttons that must be pressed to perform such a function. (See the problem in the art referenced in Col. 2, ll. 56-68; and the specific recording procedures in Figs. 5-8 and corresponding spec).

For at least these reasons, as discussed during the interview, the references fail either alone or in combination to anticipate or make obvious a method, computer-program product, or system in which a broadcast program is displayed with a hyperlink, wherein upon receiving input selecting the hyperlink the data corresponding to the hyperlink is accessed, and wherein upon obtaining the data corresponding to the hyperlink and in response to the selection of the hyperlink, the data corresponding to the hyperlink is displayed and the television program is paused in a time-shifted manner, as claimed. Moreover, and in any event, there is no motivation provided in the references to combine them in any manner.

NEW NON-FINAL OFFICE ACTION- Oct 10, 2004

The new office action rejected all of the claims under 35 U.S.C. § 102 as being anticipated by Lortz (U.S. Pat. No. 6,349,410).

AMENDMENT C– Dec 29, 2004

Amendment C, and discussions provided during an in person interview (with Mr. Jens Jenkins on 12/13/04), clarified the invention and clarified that the cited art was not prior art for the present application.

NEW NON-FINAL OFFICE ACTION- Jan 27, 2005

The new office action rejected all of the claims under 35 U.S.C. § 102 as being anticipated by Portuesi (U.S. Pat. No. 5,987,509).

AMENDMENT D– Dec 29, 2004

Amendment D, and discussions provided during an in person interview (with Mr. Jens Jenkins on 3/17/05), clarified the invention again and clarified that the cited art was not prior art for the present application. Support for the applications priority claim, to at least 5/1/96, with specific regard to the recited claim elements, was provided during the interview and subsequent telephonic discussions with the Examiner.

NEW NON-FINAL OFFICE ACTION- Apr 12, 2005

The latest office action has again rejected all of the claims. In particular, as stated, "claims 1-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Intel Intercast Technologies in view of Nakata... for the same reasons as set forth in Section 8 of the previous office action, dated 7/24/03. ... [and] "under 35 U.S.C. § 103(a) as being unpatentable over Schein...in view of Nakata...for the same reasons as set forth in Section 9 of the previous office action, dated 7/24/03."

DETAILED REMARKS

By this paper, claims 1, 10, 20, 26 have been amended.[4] No other claims have been added or cancelled. Accordingly, following this paper, claims 1-38 remain pending. Of these claims, 1, 10, 20, 26 and 32 are the only independent claims at issue.

As reflected in the claims listing, Applicant has claimed a method (claims 1, 10, 20) a corresponding computer program product (claim 26) and a system (claim 32) directed to an interactive television system that is configured for displaying television programs, hyperlinks and corresponding data, in which the display of a broadcast television program can be automatically paused in a time-shifted manner, while the television program is being broadcast/received. Furthermore, as clearly recited, the pausing of the television program is automatically performed in response to a selection of a hyperlink that is displayed with the television program, and upon obtaining the data corresponding to the hyperlink, so as to enable subsequent viewing of the paused television program in a time-shifted manner. Some of the claims also additionally recite elements that relate to resuming the display of the time-shifted programming and specific means for performing the pausing and time-shifting.

With regard to the outstanding rejections of record, identified above, Applicant strongly disagrees with the assertion that Intel Intercast discloses substantially the same interactive computer system that is configured for displaying television programs, hyperlinks and corresponding data at the interactive television system while the television program is being broadcast," as asserted. In fact, to the contrary, and as clarified in previous statements, Intel, in direct contrast to the present invention, discloses a method for using "a PC to watch TV and surf

[4] Support for the claim amendments, including the addition of the term "automatically," is clearly supported by paragraph [0117], among other passages throughout the specification. Claim 32 has not been amended to include this new term because it already has it.

the Internet ***at the same time.***" (p.1, line 1, emphasis added). The Intel technology is in fact referenced the present application (described as "intercasting, in which world wide web-like pages are distributed to television sets via the vertical blanking interval."). (Paragraph 13).

"The intercast information is currently either displayed in a split screen, or the display is toggled between the television program and the intercast information. In any event, to make use of the intercast signal the viewer must either miss part of the television program, or try to pay attention to the program while simultaneously concentrating on retrieving and understanding the intercast information. This is one of the major drawbacks of the intercast technology." (Paragraph 14).

Accordingly, although Intel identifies a method for simultaneously viewing a television program while at the same time browsing interactive content, Intel does **not** make any reference to pausing a television program, as recited in the claims, and is therefore clearly not substantially the same as Applicant's system.

Applicant is plainly aware of Intel and was aware of it at the time the application was filed. Accordingly, that is one reason why Intel was so clearly identified and distinguished in Applicant's specification.

The examiner appears to recognize the failings of Intel, as described in Applicant's specification, and therefore relies on a combination with Nakata to purportedly make obvious the claimed invention. However, the examiner's use of Nakata in such a combination is not clear. In particular, the examiner states that Nakata "teaches the concept of such well known method of pausing the display of a television program 16 that is displayed at the television system." But, it is not clear, what the examiner considers to be said "such well known method of pausing." For example, it is not clear if the examiner considers the well known method of pausing to be a general common VCR recording functionality, which is capable of virtually any VCR, or the claimed time-shift recording, which is initiated and performed in response to the selection of a hyperlink and accessing corresponding data, or some other and undescribed variety of pausing.

The examiner's rejection is even more confusing considering the remarks that have previously been made with regard to Nakata. In particular, it has been previously clarified that Nakata discloses a "multiple-deck magnetic information recording and reproducing apparatus for dubbing recorded information from one magnetic recording medium to another magnetic recording medium." (Col. 1, ll. 10-14). And even though the Nakata device includes standard

video recording capabilities, such as recording and pausing, Nakata in no way suggests or discloses any method for **temporarily pausing a television broadcast in a time-shifted way, and particularly in response to the selection of a hyperlink that is displayed with the programming.** In fact, Nakata fails to disclose the recording of broadcast television at all. Instead, Nakata discloses very specific recording procedures for beginning and ending a recording from one magnetic tape to another magnetic tape and so as to minimize the number of control buttons that must be pressed to perform such a function. (See the problem in the art referenced in Col. 2, ll. 56-68; and the specific recording procedures in Figs. 5-8 and corresponding spec).

Accordingly, among other things, Nakata clearly fails to disclose displaying a television program at the interactive television system while the television program is being broadcast, as claimed or pausing the displayed programming in response to the selection of a hyperlink, among other things. The examiner acknowledges Nakata fails to disclose displaying a broadcast program, but states that "Nakata merely provides the motivation that it would have been obvious to one of ordinary skill in the art at the time the invention was made, having both references of Intel and Nakata or Schein and Nakata...to modify the interactive television system of Intel or Schein to be upgraded as a time-shifted viewing apparatus by simply utilizing a VCR to record the live broadcast to include the same selection means and subsequent viewing equipment as specified in claims 1-38."

The foregoing statement, however, still fails to resolve the identified problem with the examiner's rejection. In particular, even assuming, *arguendo*, that Nakata did provide standard VCR capabilities, and was able to record live broadcast programming, there is still no reason for assuming that there would be a motivation for Nakata to use a VCR to implement the claimed invention to pause a broadcast program in response to the selection of a hyperlink.

Even more particularly, even if Schein and Intel, could be construed as enabling navigation of web content simultaneous with the display of broadcast television and even if Nakata could be construed as enabling VCR recording of broadcast television, there is clearly no nexus or motivation that would suggest or lead one of ordinary skill in the art to the conclusion that the forgoing combination of references would make it obvious to pause a broadcast television program, upon receiving input selecting a hyperlink displayed with the program, and

upon accessing data corresponding to the hyperlink, and such that the display of the television program is paused in the time-shifted manner recited in the claims, (see claim 1, for example), or for resuming display of the paused television program after the data corresponding to the hyperlink is displayed, such that the television program is displayed at the point at which the television program was paused, (see claim 10, for example), or for resuming display of the paused television program by accessing the signal recorded on the recording medium, while continuing to record the signal of the to the recording medium as the signal is received by the interactive television system, such that the television program is displayed at the point at which the television program was paused, (see claim 20, for example).

Accordingly, even assuming, *arguendo*, the art of record could be construed as enabling pausing of broadcast television programming during simultaneous navigation of internet content, Applicant respectfully submits that there clearly is no teaching, suggestion or motivation that pausing of the programming would occur in response to the selection of a hyperlink that is displayed with the programming, or that a program would resume displaying the programming after the data is displayed or, while continuing to record the signal, as mentioned above.

In fact, the examiner's previous assertion "that one of ordinary skill in the art would have had no difficulty in realizing that the pause function is inherently included in a remote control," clearly indicates, if anything, that it would not be obvious to initiate pause from the selection of a hyperlink, as claimed. This statement also makes it clear that there would be no motivation of one of ordinary skill in the art to require a hyperlink to be selected in order to initiate a pause of programming, particularly if the remote control already 'inherently included' that functionality. (see Section 6, Office Action of 7/24/03 (paper 11)).

For at least the foregoing reasons, provided above with regard to Intel, Schein and the purported teachings of Schein also fail to teach or disclose the claimed invention, even when considered in combination with Nakata. Accordingly, it is not necessary to address each of the the specific assertions made with regard to Schein. Nevertheless, to clarify some apparent confusion that appears to have resurfaced since the last time Schein was used to reject the claims (July 24, 2002), and to help clean up the record regarding the teachings of Schein, several of the examiner's assertions will be addressed at this time.

Initially, the examiner asserts that Schein discloses "pausing the display 410 of the television program 732 in response to the input 462 selecting the hyperlink 724." Applicant respectfully disagrees. First of all, it is not clear why the examiner selected the elements of Schein that he did, because they do not match up with the claimed elements identified in the rejection. For example, element 410 is a remote control, not a display or an act of pausing. (Figure 7, Col. 11, ln. 36), element 732 is a display screen, not a television program (Figure 13A-13C; Col. 18, ll. 54-58), and element 462 is a keyboard, not input or an act of selecting a hyperlink (Fig. 7, Col. 11, ll. 15-18). Finally, element 724, which is associated with the claimed hyperlink, is disclosed in Schein as a scrolling commercial message that advertises programs or products. Col. 18, ll. 24-28. Element 724 might be a hyperlink because, as stated in Schein, a user can navigate to the message to receive more information or to purchase a product. However, there is clearly no nexus between navigating to the message and pausing a television program. If anything, Figure 7A, which shows element 724, and the corresponding disclosure make clear that element 726 "depicts the currently tuned program"(Col 18, ll.12-13). Accordingly, if anything, this would teach away from the claims, as it appears there is no reason for pausing the programming and because it appears to be displayed at the same time, similar to the Intel Intercast ® technology.

Next, with regard to the assertion that "subsequently resuming the display of the television program 732 by accessing the signal from the recording medium 520 in the sequence in which the signal was recorded...[and] such that the television program 732 is displayed at the point at which the television program 732 was paused," Applicant respectfully disagrees for similar reasons. In particular, the recited elements simply do not match up to the corresponding claim elements. For example, element 732, as mentioned above, is a display screen, not a television program. (see above). Element 520 is also directed to a television system, not a recording medium. (Col. 13, ll. 15-20). Furthermore, even if element 732 was a program and even if element 520 was a recording medium, there is nothing in Schein to suggest that display of the program is subsequently resumed by accessing the signal from the recording medium in the sequence in which the signal was recorded, and resuming at the point at which the television program was paused. Instead, Schein merely describes recording programming guide information and related information to a memory 514 of a cable system 510.

Other assertions, such as "receiving a resume display command 410" and ceasing to display data corresponding to a hyperlink 730" and resuming display of the paused televison program 732" are also confusing and wrong for at least the same reasons. In particular, the recited elements do not match up and the recited rejections make unreasonable conclusions based on the provided disclosure in the art. For example, element 730 comprises a screen area, not a hyperlink. (Col. 18, ll. 45). However, even if it did display a hyperlink, it would still be unreasonable to conclude that art showing a displayed hyperlink and a remote control can be assumed to create a motivation for or make obvious to one of ordinary skill in the art the selection of the hyperlink with the remote control so as to initiate or otherwise cause pausing of a broadcast program.

For at least the foregoing reasons, Applicant respectfully submits again, that Schein, Intel and Nakata, fail, alone or in combination to make obvious or anticipate the claimed invention.

As further discussed during the interview, it is also clear that the art does not make any suggestion or motivation for automatically pausing a broadcast program in a time-shifted manner in response to the selection of a hyperlink, as claimed. The examiner appeared to concur with this, even though this claim limitation was already inherent in the claims, as discussed, and even though claim 32 already included this limitation. Nevertheless, to further clarify this aspect of the invention, the term automatically has been added to several of the independent claims. Accordingly, for at least this additional reason, Applicants respectfully submit that the pending claims are distinguished over the art of record.

Finally, with regard to the combination of the references cited above, Applicants also remind the Examiner, as pointed out during the interview, that there must be a motivation to combine the references and that this motivation must come from the references themselves, not the Applicant's own application[5], otherwise such a combination represents impermissible hindsight. In particular, as stated, "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in application's disclosure."[6]

[5] MPEP 2143. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).
[6] Id.

Applicants would also like to point out that, contrary to several of the Examiner's suggestions, and as further stated by the MPEP, with original emphasis provided by the MPEP, the "FACT THAT THE CLAIMED INVENTION IS WITHIN THE CAPABILITIES OF ONE OF ORDINARY SKILL IN THE ART IS NOT SUFFICIENT BY ITSELF TO ESTABLISH *PRIMA FACIE* OBVIOUSNESS. A statement that modifications of the prior art to meet the claimed invention would have been "'well within the ordinary skill of the art at the time the claimed invention was made'" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references."[7] And, again, as stated above, this motivation must come from the prior art, not Applicant's own disclosure.

With regard to the forgoing remarks, Applicant notes that many of the examiner's assertions were not specifically traversed. This was done to show that even if certain assertions were assumed, *arguendo*, to be true, the combined assertions still failed to establish a prima facie case of obviousness. Nevertheless, it will be appreciated that Applicant does not necessarily agree with the examiner's assertions and reserve the right to challenge them, at any appropriate time in the future, including any official notice.

Furthermore, although the foregoing discussion focused primarily on the independent claims, such that many of the rejections of record, such as those made to the dependent claims have not been specifically traversed, it will be appreciated that in view of the foregoing, this is not necessary that every rejection be traversed inasmuch as all of the pending claims should now be allowed and distinguished over the art of record for at least the reasons provided above. Nevertheless, Applicant reserves the right to specifically challenge any of the rejections of record, at any appropriate time in the future, should the need arise.

[7] MPEP 2143.01, *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). See also *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000).

In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney.

Dated this 22 day of June, 2005.

Respectfully submitted,

RICK D. NYDEGGER
Registration No. 28,651
JENS C. JENKINS
Registration No. 44,803
Attorneys for Applicant

Customer No. 47973

RDN:JCJ:ppa
W:\14531\71.4.2\AHM0000001286V001.DOC